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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,194	09/25/2003	Peter Kassan	K1000.0012	6395
32172	7590	07/31/2007		
DICKSTEIN SHAPIRO LLP 1177 AVENUE OF THE AMERICAS (6TH AVENUE) NEW YORK, NY 10036-2714			EXAMINER ALLEN, WILLIAM J	
			ART UNIT 3625	PAPER NUMBER
			MAIL DATE 07/31/2007	DELIVERY MODE PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

JUL 31 2007

GROUP 3600

Application Number: 10/671,194
Filing Date: September 25, 2003
Appellant(s): KASSAN, PETER

Michael J. Scheer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/14/2007 appealing from the Office action mailed 10/12/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Under Section VI. D. please note the rejection of Claims 9 and 10 under 35U.S.C. 103(a) as being unpatentable over Ximenes in view of Mulvey, US Publication number 20030208718

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2003/0069811	Ximenes et al.	04-2003
US 4,839,829	Freedman	06-1989
US 6,535,294	Arledge et al.	05-2003
US 2003/0208718	Mulvey et al.	06-2003
US 2002/0010638	Fischer	01-2002
PTO form 892 reference U		11-2002
PTO form 892 reference V		2001
PTO form 892 reference X		08-2001
PTO form 892 reference UU		11-2002
PTO form 892 reference VV		1996

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-2, 8, 12-13, 15, 18-20, 23-24, 29, 40, 44, 46-47 and 50-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Ximenes et al. (US 2003/0069811, herein referred to as Ximenes).**

Regarding claim 1, Ximenes teaches:

providing add-in software operable with a web site, the add-in software enabling a visitor of the web site to submit a request for receiving a printed copy of web hosted information that is displayable as web pages (see at least: 0018, 0023, 0025, 0027, 0039, 0050, 0068, Fig. 2); According to the Microsoft Press Computer Dictionary, third edition, an add-in/add-on program is “a supplemental program that can extend the capabilities of an application program”. The Examiner notes that the “web client”, “web browser”, “access software”, “image editing software”, and the like (e.g. Adobe, Bluetooth, etc.) represent add-in software that enable the user to submit an order via the web.

receiving electronic order information representing the request (see at least: 0007, 0044-0045, claim 15);

processing the electronic order information to provide electronic production information representing instructions for fulfilling the request (see at least: 0007, 0029, 0044-0045, 0050, 0059, claim 15);

transmitting the electronic production information to a fulfillment facility (see at least: 0007, 0029, 0044-0045, 0050, 0059, claim 15); and

providing to the visitor the requested web hosted information from the fulfillment facility in the form of printed pages (see at least: 0032, 0051-0052).

Regarding claim 2, Ximenes teaches *wherein the electronic order information is prepared by the add-in software (see at least: 0034, 0038-0050).* The Examiner notes that the add-in software components facilitate the collection and transmission of order information such as visual image, format, and various other print information such as color, size, changing/editing the image etc.

Regarding claim 8 and 12 Ximenes teaches:

(8) wherein the step of preparing the electronic order information comprises selecting a style for the printed pages, the style including at least one of page layout, inside and outside of a front cover, inside and outside of a back cover, double-sided printing, and single sided printing (see at least: 0054). The Examiner notes that the user can decide on images, dedication, etc. for the cover or covers (i.e. front or back covers).

(12) wherein the step of choosing the style includes generating a new style and modifying an existing style (see at least: 0054). The Examiner notes that when a user specifies a user selected image, provides a dedication, biography, etc. that the user is generating a new style. Additionally, when a user chooses to modify a selected image (see at least: 0050, 0056).

Regarding claim 13, Ximenes teaches *wherein the print pages are packaged with at least one other item* (see at least: 0007, 0052). The Examiner notes that the image may be framed (i.e. the frame is another item) or unframed.

Regarding claim 15, Ximenes teaches *wherein the step of processing electronic information comprises providing at least one of front information, back information, and spine information* (see at least: 0054).

Regarding claim 18-20, Ximenes teaches:

(18) *wherein the add-in software further enables a user to provide at least one of related personal and professional information* (see at least: abstract, 0007, 0034).

(19) *wherein the add-in software further provides customer web site information, the customer web site information regarding at least one of the uniform resource locator of the web site, the IP address of the web site and the name of the proprietor of the web site* (see at least: 0025,). The Examiner notes that when accessing the various web pages/servers via the web client/browser on the ordering portal an IP address is provided to the portal in use.

(20) *providing a production web site, the production web site providing prospective customers information regarding providing the printed pages* (see at least: 0007, 0020).

Regarding claim 23-24, Ximenes teaches:

(23) *wherein the fulfillment facility provides the printed pages such that they have been subject to at least one of folding, binding and saddles stitching* (see at least: 0054).

(24) further comprising at least one of transmitting an invoice for the printed pages and receiving electronic payments for providing the printed pages (see at least: abstract, 0004).

Regarding claim 29, the limitations set forth in claim 29 closely parallel the limitations set forth in claim 1. Claim 29 is thereby rejected under the same rationale.

Regarding claim 40, Ximenes teaches *wherein the communications network is the Internet* (see at least: 0007).

Regarding claim 44 and 46-47, Ximenes teaches:

(44) a simulation module that provides an electronic simulated representation of the formatted print pages (see at least: 0050, 0056).

(46) wherein the electronic simulation is at least a partial representation of the formatted print pages (see at least: 0050, 0056). The Examiner notes that one edited, the image is a full representation of the print page.

(47) wherein the electronic request comprises the electronic simulated representation (see at least: 0050, 0056). The Examiner notes that an order for the edited image is placed.

Regarding claim 50 and 51, Ximenes teaches

(50) *an e-commerce module performs at least one of generating a cost for receiving formatted print pages and accepting payment for formatted print pages* (see at least: abstract, 0004, 0034, 0036, 0048).

(51) *wherein the formatted print pages include at least one of a company's annual report, a wall calendar, a desk calendar and a poster* (see at least: 0002, 0004).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 3-6, 41-43, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ximenes in view of Freedman (US 4,839,829).**

Regarding claim 3-5, Ximenes teaches all of the above and further teaches providing a price to a user (see at least: 0048). Ximenes, however, does not expressly teach *providing an estimation for costs associated with providing the printed pages wherein the estimate is partly based on the requested style for the printed pages and wherein the style includes at least one of binding, saddle-stitching, paper size, two-sided printing, and full bleed printing*. Freedman teaches *providing an estimation for costs associated with providing the printed pages wherein the estimate is partly based on the requested style for the printed pages* (see at least: col. 2 lines 6-38, col. 10 lines 55-col. 11 line 25, Fig. 3A-3B) and *wherein the style includes at least one of binding, saddle-stitching, paper size, two-sided printing, and full bleed printing* (see at least: col. 11 lines 11-25). It would have been

obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Ximenes to have included *providing an estimation for costs associated with providing the printed pages wherein the estimate is partly based on the requested style for the printed pages and wherein the style includes at least one of binding, saddle-stitching, paper size, two-sided printing, and full bleed printing* as taught by Freedman in order to provide a system that quickly assesses the customer's specific printing requirements with regard to the capacity or capabilities of numerous printing facilities. (see at least: Freedman, col. 2 lines 39-41).

Regarding claim 6, Ximenes teaches all of the above as noted and further teaches add-in software allowing a user to select from previously stored images and modify the images using photo editing software (see at least: 0050, 0056). Ximenes, however, does not expressly teach where the visitor *selects a predefined layout and modify the predefined layout*. Freedman teaches the visitor *selecting a predefined layout and modify the predefined layout*. Freedman teaches *selecting a predefined layout and modify the predefined layout* (see at least: col. 1 line 38-41, col. 8 line 21-col. 9 line 2). The Examiner notes that once a requester has placed an order using a pre-stored template, that user may return to that order to modify the printing job (i.e. modify the template being used by changing parameters, etc.). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Ximenes to have included *selecting a predefined layout and modify the predefined layout* as taught by Freedman in order to provide a system that quickly assesses the customer's specific printing requirements with regard to the capacity or capabilities of numerous printing facilities. (see at least: Freedman, col. 2 lines 39-41).

Regarding claims 41-42, the limitations set forth in claims 41-42 closely parallel the limitations set forth in claims 5 and 6. Claims 41-42 are thereby rejected under the same rationale.

Regarding claim 43, Ximenes teaches all of the above as noted and further teaches add-in software allowing a user to select from previously stored images and modify the images using photo editing software (see at least: 0050, 0056). Ximenes, however, does not expressly teach *wherein the formatted print pages style module provides tools for manipulating a selected formatted print pages style template*. Freedman teaches *wherein the formatted print pages style module provides tools for manipulating a selected formatted print pages style template* (see at least: col. 8 line 21-col. 9 line 2). The Examiner notes that the user manipulates the template by selecting the parameters desired. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Ximenes to have included *wherein the formatted print pages style module provides tools for manipulating a selected formatted print pages style template*. Freedman teaches *wherein the formatted print pages style module provides tools for manipulating a selected formatted print pages style template* as taught by Freedman in order to provide a system that quickly assesses the customer's specific printing requirements with regard to the capacity or capabilities of numerous printing facilities. (see at least: Freedman, col. 2 lines 39-41).

Regarding claim 45, Ximenes teaches all of the above as noted and further teaches add-in software allowing a user to select from previously stored images and modify the images using photo editing software (see at least: 0050, 0056). Ximenes, however, does not expressly teach *an approval module that prompts the viewer for approval*. Freedman teaches *an approval module that prompts the viewer for approval* (see at least: col. 8 line 21-col. 9 line 2). It would have been obvious to one

of ordinary skill in the art at the time of invention to have modified the invention of Ximenes to have included *an approval module that prompts the viewer for approval* as taught by Freedman in order to provide a system that quickly assesses the customer's specific printing requirements with regard to the capacity or capabilities of numerous printing facilities. (see at least: Freedman, col. 2 lines 39-41).

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ximenes in view of PTO 892 reference X (herein referred to as 892x).

Regarding claim 7, Ximenes teaches all of the above but does not expressly teach *wherein the printed pages are provided by printing on oversized paper and trimming the oversized paper*. 892x teaches *wherein the printed pages are provided by printing on oversized paper and trimming the oversized paper* (see at least: Paragraph 29). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Ximenes to have included *wherein the printed pages are provided by printing on oversized paper and trimming the oversized paper* as taught by 892x in order to provide near perfect-bound books without a large guillotine cutter (see at least: 892x, Paragraph 29).

6. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ximenes in view of Mulvey et al. (US 2003/0208718, herein referred to as Mulvey).

Regarding claim 9, Ximenes teaches all of the above as noted and further teaches *where choosing an image (i.e. style) includes making a selection from a plurality of low-resolution,*

compressed images (see at least: 0057). Ximenes, though teaching low-resolution, compressed images, does not expressly teach the use of *thumbnails* Mulvey teaches the use of *thumbnails* in selecting a coupon design type (see at least: 0028- 0029). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Ximenes to have includes *thumbnails* representing styles as taught by Melvin in order to provide to reduce storage space while providing a user with an idea of what the true image is looked like (see at least: Ximenes, 0057).

Regarding claim 10, Ximenes further teaches modifying selected images (see at least: 0050, 0056) Ximenes, however, does not expressly teach *wherein the visitor provides a request a modification to the style* (see at least: 0050, 0056). Melvin teaches *wherein the visitor provides a request a modification to the style* (see at least: 0033). The Examiner notes that by selecting the edit button , the user is requesting to modify the coupon design (i.e. style). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Ximenes to have included *wherein the visitor provides a request a modification to the style* as taught by Melvin in order to allow the user to easily return to the web screen to modify the information that was input (see at least: Melvin, 0033).

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ximenes in view of Mulvey, as applied to claims 9-10, and in further view of Fischer (US 2002/0010638).

Regarding claim 11, Ximenes in view of Mulvey teach all of the above as noted and further teach making a request to modify a style (see at least: Mulvey, 0033). Ximenes in view of Mulvey,

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however, does not expressly teach making the request *via email*. Fischer teaches making a request to modify an order *via email* by revising an order and sending an email in reply (see at least: 0022). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Ximenes in view of Mulvey to have included sending a request for modification via email as taught by Fischer in order to provide an easy means of communicating changes to an order between a vendor and a customer.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ximenes in view of PTO 892 reference u (herein referred to as 892u).

Regarding claim 14, Ximenes teaches all of the above as noted and further teaches packaging an ordered image with at least one other item (see at least: 0007, 0052). Ximenes, however, does not expressly teach where the second item is *advertising material*. 892u teaches packaging free mail in offers (i.e. advertising material) with various brands of cereal (see at least: Paragraphs 1 and 4). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Ximenes to have included packaging the purchased product with *advertising material* in order to spur repeat buying by advertising offers requiring multiple purchases, thereby increasing revenue for a company (see at least: Paragraphs 1 and 4).

9. Claims 16-17 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ximenes in view of PTO 892 reference v (herein referred to as 892v).

Regarding claim 16, Ximenes teaches all of the above and further teaches specifying information for the cover or covers (see at least: 0054). Ximenes, however, does not expressly show where the front information comprises at least one of a *table of contents, forward and advertising*. 892v teaches front information comprising a *table of contents, forward and advertising* (see at least: Pages 2-5 and 10). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Ximenes to have included front information comprising a *table of contents, forward and advertising* as taught by 892v in order to provide user selectable information that also aids a reader of the printed material in obtaining necessary information.

Regarding claim 17, Ximenes teaches all of the above and further teaches specifying information for the cover or covers (see at least: 0054). Ximenes, however, does not expressly show where the back information comprises at least one of a *an index, appendix, a table and a glossary*. 892v teaches back information comprising a *an index, appendix, a table and a glossary* (see at least: Pages 6-9). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Ximenes to have included back information comprising a *an index, appendix, a table and a glossary* as taught by 892v in order to provide user selectable information that also aids a reader of the printed material in obtaining necessary information.

Regarding claims 25-26, Ximenes teaches all of the above but does not expressly teach where the provided printed pages of the selected book *comprise ownership information wherein the ownership information includes copyright and production information, the production information including information regarding the fulfillment city*. 892v teaches providing ownership information wherein the ownership information includes copyright and production information, the production

information including information regarding the fulfillment city (see at least: Pages 1-3). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Ximenes to have included book *comprise ownership information wherein the ownership information includes copyright and production information, the production information including information regarding the fulfillment city* as taught by 892v in order to provide a demonstration of the right of a printing/publishing entity to commercialize, license, transfer, broadcast or reproduce an original piece of work as is known in the art (see at least: 892v, Pages 1-3).

10. Claims 21-22, and 30-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ximenes in view of Arledge Jr. et al. (US 6,535,294, herein referred to as Arledge).

Regarding claims 21-22 and 30, Ximenes teaches all of the above as noted and further teaches *a production information processor providing the add-in software and providing a production web site* (see at least: 0018, 0023, 0025, 0039, 0050, 0068). Ximenes, however, does not expressly teach the production web site *comprising at least public content for registered and non-registered visitors, and private content for registered visitors*. Arledge teaches a web site *comprising at least public content for registered and non-registered visitors* (see at least: Fig. 4, 5, 16 #363), and *private content for registered visitors* (see at least: col. 9 lines 65-67, col. 13 lines 15-53). The Examiner notes that the preparation apparatus/service (i.e. private content) is only available to a registered user once the user has input proper log in information. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Ximenes to have included the production web site *comprising at least public content for registered and non-registered visitors, and private content for registered visitors* as taught by Arledge in order to provide a system

and method for preparing customized printed products, wherein an end-user thereof uses a product design, layout and preparation system over a quasi-public communications network, such as the Internet, to prepare, in realtime, the customized printed products (see at least: Arledge, col. 2 lines 60-65).

Regarding claim 31, Arledge also teaches *wherein the public content comprises information regarding at least one of the add-in software, the request receiving module, the request processing module, the transmitting module and the formatted print pages delivery module* (see at least: Fig. 16, col. 17 line 66-col. 18 line 7). The Examiner notes that by providing benefits of registering with the system/service (which comprises add-in software, processing, transmitting, and formatted pages modules [see at least: Fig. 1, col. 3 lines 43-46]) Arledge provides *information regarding the system/service (and thereby its components)*. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Ximenes to have included *wherein the public content comprises information regarding at least one of the add-in software, the request receiving module, the request processing module, the transmitting module and the formatted print pages delivery module* as taught by Arledge in order to provide a system and method for preparing customized printed products, wherein an end-user thereof uses a product design, layout and preparation system over a quasi-public communications network, such as the Internet, to prepare, in realtime, the customized printed products (see at least: Arledge, col. 2 lines 60-65).

Regarding claim 32, Arledge further teaches *wherein the private content comprises at least one of content received from the web site and content not received from the web site, wherein the content is to be included in the formatted print pages* (see at least: col. 9 lines 65-67, col. 13 lines 15-

53). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Ximenes to have included the production web site *comprising at least public content for registered and non-registered visitors, and private content for registered visitors* as taught by Arledge in order to provide a system and method for preparing customized printed products, wherein an end-user thereof uses a product design, layout and preparation system over a quasi-public communications network, such as the Internet, to prepare, in realtime, the customized printed products (see at least: Arledge, col. 2 lines 60-65).

Regarding claims 33-39, Ximenes further teaches:

(33) *a search module, the search module providing a location of content related to content provided in the web site* (see at least: 0007, 0018, 0034).

(34) *wherein content located by the search module is included in the formatted print pages* (see at least: 0007, 0018, 0034). The Examiner notes that the located content is chosen by the user to be printed.

(35) Ximenes teaches all of the above and further teaches the use of format printers made by Epson, Roland and Iris. (see at least: 0007). The Examiner notes that each of Epson, Roland, and Iris manufacture various types of printers such as ink jet, bubble jet, laser, and the like; thereby, Ximenes teaches the use of such printers.

(36) *wherein the electronic request includes electronic content information representing the content for the formatted pages, and control information representing at least a style of the formatted print pages* (see at least: abstract, 0005, 0007, 0050, 0054, 0056). By specifying a visual image and any modifications, the user is specifying the style.

(37) *wherein the control information further comprises at least one of an identification of the web site, the portion of the web site for the formatted print pages, and the version of the formatted print pages (see at least: abstract, 0005, 0007, 0050, 0054, 0056).*

(38) *wherein the control information further comprises at least one of the name, mailing address, shipping specifications and e-mail address of the party submitting the electronic request (see at least: 0034, 0052).*

(39) *wherein the style of the formatted print pages includes at least one of the front matter, the back matter, and components that are repeated in the formatted print pages (see at least: 0054).*

11. Claims 27 and 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ximenes in view of PTO 892 reference uu (herein referred to as 892uu).

Regarding claim 27, Ximenes teaches all of the above but does not expressly teach *storing a style in a database corresponding to respective visitors, and selecting a stored style for respective visitors in future production of printed pages*. 892uu teaches *storing a style in a database corresponding to respective visitors, and selecting a stored style for respective visitors in future production of printed pages*. Users upload photos (i.e. styles) and have the photos stored with the Snapfish server (see at least: Page 1 a & B, Page 2 C). Additionally, users may edit photos and save the changes (see at least: Page 8 D, Page 11 E). The stored photos (i.e. styles) are selectable for future orders. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Ximenes to have included *storing a style in a database corresponding to respective visitors, and selecting a stored style for respective visitors in future production of*

printed pages as taught by 892uu in order to provide a convenient means of storing/editing photos and ordering professionally developed prints from a user account (see at least: 892uu, Pages 1-2).

Regarding claims 48-49, Ximenes teaches all of the above but does not expressly teach a *subscription module that prompts the visitors to enter into a subscription agreement for receiving future formatted print pages wherein a single payment for a plurality of orders for formatted print pages is provided by the visitor*. 892uu teaches a *subscription module that prompts the visitors to enter into a subscription agreement for receiving future formatted print pages wherein a single payment for a plurality of orders for formatted print pages is provided by the visitor*. A user of the service signs up (i.e. subscribes via a subscription module) for receiving formatted photos in the future (see at least: Page 1 F & G, Page 2 H). 892uu also teaches accepting a *single payment for a plurality of orders for formatted print pages is provided by the visitor* (see at least: Page 3 I, Page 4 J). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Ximenes to have included *subscription module that prompts the visitors to enter into a subscription agreement for receiving future formatted print pages wherein a single payment for a plurality of orders for formatted print pages is provided by the visitor*. 892uu teaches a *subscription module that prompts the visitors to enter into a subscription agreement for receiving future formatted print pages wherein a single payment for a plurality of orders for formatted print pages is provided by the visitor* as taught by 892uu in order to provide a convenient means of storing/editing photos and ordering professionally developed prints from a user account (see at least: 892uu, Pages 1-2).

12. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ximenes in view of PTO 892 reference vv (herein referred to as 892vv).

Regarding claim 52, Ximenes teaches all of the above as noted and further teaches on demand printing for previously published works (see at least: abstract). Ximenes, however, does not expressly teach where the work is *an article previously published in a previously printed magazine*. 892vv teaches where the work is *an article previously published in a previously printed magazine* (see at least: Paragraphs 1-5 and 9). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Ximenes to have included where the work is *an article previously published in a previously printed magazine* as taught by 892vv in order to maximize profit from sale of reprints (see at least: 892vv, Paragraph 5).

(10) Response to Argument

Applicant's arguments filed in the instant appeal brief have been fully considered but they are not persuasive.

Ximenes discloses a system and method for purchasing reproductions of visual images on demand. As part of the system, Ximenes includes add-in software such as a “web client” complete with a web browser, “access software”, “image editing software”, and the like (e.g. Adobe, Bluetooth, etc.) (see at least: 0018, 0023, 0025, 0039, 0050, 0068). According to the Microsoft Press Computer Dictionary, third edition, an add-in/add-on program is “a supplemental program that can extend the capabilities of an application program”. As an illustrative example, Ximenes teaches the ordering portal comprising software imparting desired interface functionality such as a “web client”, and further shows where that functionality can be extended to facilitate payment (see at least: 0025). The web client may also comprise a web browser, and the web browser may have a corresponding catalog server which further comprises additional access software (see at least: 0039). As another example, the ordering server can further comprise software such as that offered by VeriSign to accommodate payment (see at least: 0027).

More specifically, the Examiner disagrees with Applicant's assertion that Ximenes fails to teach the aspect of printing “web hosted information **displayable as web pages**” for at least the following reasons:

- I. The catalog/library server and ordering server are connected via the web/internet to the ordering portal (see at least: 0007)
- II. The catalog/library contains information on visual images available for selection and reproduction, with the library of visual images accessible by the user through the ordering portal via the web/internet (see at least: abstract, 0020)

III. For each image in the library there is a displayable reproduction of the image (see at least: 0036, 0040)

IV. Using a web client with a web browser, a user accesses the catalog/library of visual images hosted on the web server (see at least: abstract, 0020).

[It is noted that in Applicant's own arguments Applicant has conceded these points (see: Page 8 final paragraph – Page 9 of Applicant's remarks)].

The catalog/library information is hosted on the catalog server, which in turn is hosted on the web (i.e. the catalog information is "web hosted information") and displayed via the web browser. To reiterate, the catalog/library is hosted on the web, displayed to a user via a webpage through the web browser, and is printed at the print facility as a result of a purchase order by a user. Additionally, Applicant's ^{specification} provides little guidance as how the aforementioned "web pages" are distinguishable from the cited art, and merely recites such features as printing content that is "displayable as web pages" (see paragraph 0018) or "content represented in a web site" (see paragraphs 0019, 0029, 0031, 0037).

The Examiner emphasizes that a web page, in any case, is merely a reproduction of data and code into a displayed page. In the case of Ximenes, the catalog/library information hosted on the web forms part of the data and code that is displayed by the web browser as a web page. Thereby, the catalog/library information constitutes web hosted information that is displayable as a web page.

Despite these teachings, it is also notable that the language of the claim states simply that the web hosted information is "display^{able}" as web pages. In other words, the language of the claim merely requires the condition that the web hosted information be able to be displayed as a web page, and does not positively require the web hosted information to be displayed as a web page.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

William J. Allen



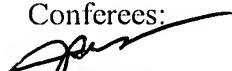
Patent Examiner

July 17, 2007



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Conferees:



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Vincent Millin, Appeals Specialist